

REMARKS**I. General**

Claims 1-36 are pending in the present application. Claims 1, 2, 6-16, 21-25, and 27-35 stand rejected under 35 U.S.C. § 102(b). Claims 3-5, 17-20, 26, and 36 stand rejected under 35 U.S.C. § 103(a). In the present Amendment, claims 1, 12, 14, 16, and 25 have been amended, and claims 2, 3, 17, 18, and 26 have been canceled. Accordingly, claims 1, 4-16, 19-25, and 27-36 will remain pending after entry of the present Amendment. Applicant respectfully traverses the rejections of record.

II. Objection to the Specification

The objection to the specification questions the status of application 09/491,949 in paragraph number [0001] appearing at page 1. Applicant respectfully asserts that the data contained in paragraph number [0001] accurately reflects the current status of the referenced application. Accordingly, it is respectfully asserted that the objection with respect to the specification should be withdrawn.

III. The 35 U.S.C. § 102 Rejections

Claims 1, 2, 6-16, 21-25, and 27-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schuessler, United States patent number 2,964,323 (hereinafter *Schuessler*). To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for an applied reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the ...claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). *Schuessler* does not teach every element of the above claims and does not show the identical invention in as complete detail as is contained in the claims.

Claim 1 has been amended to recite the limitations originally submitted in claims 2 and 3. Accordingly, claim 1, as amended, recites “...said postal item bearing said postal indicia is a computer generated document, and wherein said postage indicia is printed directly upon said postal item at a time of printing said computer generated document.” Applicant’s

review of the disclosure of *Schuessler* does not reveal any discussion of printing a postage indicia directly on the postal document during the document's printing process. As such, claim 1 is patentable over the 35 U.S.C. § 102 rejection on the record. The limitations of claim 1, amended to recite the limitation of originally submitted claim 3, are addressed further below with reference to the 35 U.S.C. § 103 rejection of claim 3.

Claim 16 has been amended to recite the limitations originally submitted in claims 17 and 18. Accordingly, claim 16, as amended, recites "...printing said postage indicia, using said computer system, simultaneously with printing said piece of correspondence." *Schuessler* does not disclose a method for generating a piece of correspondence by printing the postal document and postage indicia simultaneously. Therefore, claim 16 is patentable over the 35 U.S.C. § 102 rejection on the record. The limitations of claim 16, amended to recite the limitations of originally submitted claims 17 and 18, are addressed further below with reference to the 35 U.S.C. § 103 rejections of claims 17 and 18.

Claim 25 has been amended to recite the limitation originally submitted in claim 26. Accordingly, claim 25, as amended, recites "...said piece of correspondence and the postage indicia thereon are printed by a computer system." The disclosure of *Schuessler* does not reveal a piece of correspondence with postage indicia thereon printed by a computer system. As such, claim 25 is patentable over the 35 U.S.C. § 102 rejection on the record. The limitations of claim 25, amended to recite the limitation of originally submitted claim 26, are addressed further below with reference to the 35 U.S.C. § 103 rejection of claim 26.

Claims 6-15, 21-24, and 27-35 depend from claims 1, 16, and 25 respectively, and therefore incorporate the limitations thereof. As shown above, each of claims 1, 16, and 25 are patentable over the 35 U.S.C. § 102 rejections on the record based upon *Schuessler*. Accordingly, claims 6-15, 21-24, and 27-35 are asserted to be patentable over the rejections of record at least for the reasons set forth above.

IV. The 35 U.S.C. § 103 Rejections

Claims 3, 17, 18, 26, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schuessler* in view of legal precedent stating it is obvious to replace manual activity with automatic activity as set forth in *In re Venner and Bowser*, 120 U.S.P.Q.

192, 194 (CCPA, 1958). Claims 4, 5, 17, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schuessler* in view of either Sansone et al., United States patent number 4,724,718 (hereinafter *Sansone*), Gunn, Great Brittan patent number 1380590 (hereinafter *Gunn*), or Gilham, European patent number 0331352 (hereinafter *Gilham*).

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references lack all the claim limitations.

1. Rejections Based Upon *Schuessler* in View of The Legal Precedent

Claims 3, 17, 18, and 26 stand canceled, however claims 1, 16, and 25 have been amended to recite the limitations of claims 3, 17, 18, and 26 respectfully. Regarding the limitations of claims 1, 16, 25, and 36 the Office Action states that *Schuessler* suggests that “it is desirable to reduce the time required to complete forms to make this process more efficient” and “the information that is to be placed in specified locations on the contents of the envelope is performed manually by the user,” the Office Action at page 4. The Office Action further states that “it is well known that the use of a computer to complete and generate various forms speeds up the processing of the forms as a whole,” and therefore concludes that “it would have been obvious to one of ordinary skill at the time of the invention that the manual completion of contents 10 of the envelope 31 by the user of *Schuessler* (‘323) could be automatically performed by a computer system in order to save time and make the process more efficient.” *Id.*

Applicant respectfully asserts that one of ordinary skill in the art would not have been enabled to modify the system of *Schuessler* to replace the manual completion of the deposit ticket thereof with automatic completion of the deposit ticket using a computer system as proffered in the Office Action. In column 3, lines 11-27, *Schuessler* teaches the depositor writing deposit entries upon the deposit ticket, using carbon if a copy is desired, and affixing

an adhesive stamp to the deposit ticket. The general knowledge that it is desirable to automate manual activity in order to save time and make the process more efficient is insufficient to have enabled one of ordinary skill in the art to have created a computer system not only capable of automatically completing each of portions 21, 26, and 16 of deposit ticket 10, but also to generate and print a postage indicia within stamp section 30 with no other guidance whatsoever. The present specification provides great detail with respect to systems to enable the foregoing which, without the benefit of hindsight gleaned from the Applicant's own specification, would not have been obvious to one of skill in the art from a review of *Schuessler* or other art available at the priority date attributable to the present claims. Therefore, Applicant contends claims 1, 16, 25, and 36 are patentable over the 35 U.S.C. § 103 rejections of the record.

In Addition, claims 1 and 16 have been amended to require the postal item and postage indicia be printed at the same time which creates the advantage of printing the postal item and postage indicia during one pass across a blank writing medium. Column 3, lines 11-12 in *Schuessler* teaches a deposit ticket provided by the bank, and column 3, line 13 explains a depositor may then make deposit entries upon the deposit ticket. Although *Schuessler* discusses affixing a postage stamp or a mail permit stamp to the deposit ticket, *Schuessler* does not teach or suggest affixing such a stamp to the deposit ticket at the time of printing the deposit ticket, see column 2, lines 48-50. Accordingly, the limitations of claims 1 and 16 are not met because there is nothing to have suggested printing a postage indicia directly upon the postal item at the time of printing the postal item. As such, claims 1 and 16 are patentable over the 35 U.S.C. § 103 rejections of the record.

Original claims 4-15, 19-24, and 27-35 depended from claims 1, 16, and 25 respectively and inherit the limitations therein. Therefore, at least for the reasons set forth above, claims 4-15, 19-24, and 27-35 are patentable over the 35 U.S.C. § 103 rejections based on *Schuessler* in view of replacing manual activity with automatic activity.

2. Rejections Based Upon *Schuessler* in View of *Sansone*, *Gunn*, or *Gilham*

Claims 4, 5, 19, and 20 depend from independent claims 1 and 16 respectively and thus incorporate the limitations therein. Applicant has shown above that *Schuessler* does not

teach or suggest the limitations of the independent claims. The rejections of record with respect to dependent claims 4, 5, 19, and 20, relying upon the disclosure of *Sansone*, *Gunn*, or *Gilham*, do not cure the above identified deficiencies in *Schuessler*. Furthermore, Applicant's review of the disclosure of *Sansone* does not reveal a postmark with a machine readable portion or a barcode, instead *Sansone* discusses a motor vehicle gear shift. Therefore, dependent claims 4, 5, 19, and 20 are asserted to be patentable over the 35 U.S.C. § 103 rejections of the record at least for the reasons set forth above with respect to independent claims 1 and 16.

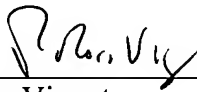
V. Summary

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P004CP1CP1C2/10107404 from which the undersigned is authorized to draw.

Dated: January 20, 2005

Respectfully submitted,

By 
R. Ross Viguet
Registration No.: 42,203
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8185
(214) 855-8200 (Fax)
Attorney for Applicant